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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,968	10/01/2003	Paul J. Claussen	A-9428	8126

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

SAWAGED, SARI S

ART UNIT	PAPER NUMBER
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4126

NOTIFICATION DATE	DELIVERY MODE
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11/02/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@sciatl.com

Office Action Summary

Application No.

10/676,968

Applicant(s)

CLAUSSEN ET AL.

Examiner

Sari Sawaged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed applications, Application No. 10/008,581 and provisional application 60/248,485, fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior filed applications fail to disclose proximity detection and STB deactivation, which is the crux of the claimed invention. The date of all claims will be considered 10/1/2003, which is the filing date of this application.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1, 6, 7, and 8 are rejected under 35 USC 102(e) as being unpatentable over Bero et al. (hereinafter referred to as Bero) (US 2003/0063003).**
2. Regarding claim 1, Bero discloses a system for detecting the presence of a remote device comprising: a primary device having a wireless accessory for detecting the presence of at least one remote device, wherein the primary device determines the presence of the at least one remote device by determining a distance between the primary and remote devices, wherein when the primary device determines the distance to be within a predetermined distance, the remote device continues to receive signals (See paragraph 0016 lines 1-7 and paragraph 0018 lines 7-12).
7. Regarding claim 6, Bero discloses that a slave unit is sent a desired distance from the master unit and the master unit stores the signal strength. This is essentially is the predetermined distance that is claimed in claim 6 (See paragraph 0024 lines 11-13).
8. Regarding claim 7, Bero discloses using received signal strength measurements to determine the distance of slave units (See paragraphs 0032 lines 1-3). This measurement is used to determine the distance of the slave unit. If the signal is weaker than the predetermined threshold, then the distance of the slave unit is greater than the predetermined distance. If the signal strength is stronger than the slave unit is at a closer distance than the predetermined distance.

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9. Regarding claim 8, Bero discloses using Bluetooth with a received signal strength indicator (RSSI) (See paragraph 0013 lines 7-12 and paragraph 0016 lines 1-7). Using UWB communications is an obvious variant of Bero's invention because UWB is also useful in short distance communication. Bero discloses his motivation for using Bluetooth due to it being very compact, cost effective, and most effective in picocell local area networks.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 2, 3, 4, 5, 9, 10, 11, 12, 13, 14, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bednarek et al. (hereinafter referred to as Bednarek) (US 5,621,793) in view of Bero.**

5. Regarding claim 2, Bednarek discloses a system where GPS positioning is used to determine whether a set top box is within a predetermined distance of an authorized location, if the set top box is outside the authorized location by a predetermined threshold then the set top box will not be able to descramble signals. (See column 3

lines 6-10 and lines 48-50). Bednarek doesn't disclose a primary and a secondary device or that the proximity of the secondary device is with reference to the main device's position. However, Bero discloses a primary device and a secondary device and the proximity of the secondary device is measured with respect to the primary device's position (See paragraph 0016 lines 1-7) . It would have been obvious to combine Bednarek's invention with Bero's invention at the time the invention was made because it would have been cheaper and easier to implement.

6. Regarding Claims 3-5, Bednarek discloses communication between a central access control and transmission medium for transmission to customer (the examiner understands this to mean communication with the headend facility as it is well known in the art that set top boxes are two way communicating devices and are in communication with the headend) (See column 3 lines 25-27). Bednarek discloses that a "conditional accesser" requests position information from the STB and the STB sends this information to the conditional accesser (See column 5 lines 30-33).

Bednarek doesn't specifically disclose that the primary device receives a proximity detection request from a headend facility or the headend facility discontinues service if it received a signal indicating an absence of at least one remote device. Bednarek doesn't disclose that the headend sends a signal to the primary device directing it to no longer communicate with at least one remote device. These claims, however, are obvious variations of the inventions as disclosed by Bednarek and Bero because they take the localized actions disclosed by Bednarek and Bero and delegate

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these actions to the headend facility. Set top boxes are also well known in the art at the time the invention was made to be two way communication devices and it would have been obvious for the primary device to alert the headend when a secondary device is outside of the proximity of the primary device indicating possible unauthorized access to services.

10. Regarding claim 9, Bednarek discloses a system where GPS positioning is used to track the location of STBs and disabling the STBs if they are outside their stored/predetermined locations (proximity to the predetermined location) (See column 13 lines 6-9 and Column 5 lines 10-18 and column 12 lines 11-31). Bednarek doesn't disclose a remote device in communication with a primary device or a wireless accessory that detects the presence/absence of at least one remote device and determines the distance between the primary device and if the primary device determines the distance to be within a predetermined distance the remote device continued receiving signals. However, Bero discloses a wireless accessory, a primary device and at least one secondary device, the primary device detects the presence or absence of the secondary device and if the secondary device is within a predetermined distance no action or alerts are invoked (See paragraph 0016 lines 1-12 and paragraph 0013 lines 1-12). It would have been obvious to one of ordinary skill in the art to combine Bednarek's invention with Bero's invention because it would have been cheaper and simpler to implement.

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11. Regarding claim 10, Bednarek discloses that access to signals is authorized only if the location of the device is at the authorized customers place (See column 3 lines 6-10).

12. Regarding claims 11-13, Bednarek discloses communication between a central access control and transmission medium for transmission to customer (the examiner understands this to mean communication with the headend facility as it is well known in the art that set top boxes are two way communicating devices and are in communication with the headend) (See column 3 lines 25-27). Bednarek discloses that a "conditional accesser" requests position information from the STB and the STB sends this information to the conditional accesser (See column 5 lines 30-33).

Bednarek doesn't specifically disclose that the primary device receives a proximity detection request from a headend facility or the headend facility discontinues service if it received a signal indicating an absence of at least one remote device. Bednarek doesn't disclose that the headend sends a signal to the primary device directing it to no longer communicate with at least one remote device. These claims, however, are obvious variations of the inventions as disclosed by Bednarek and Bero because they take the localized actions disclosed by Bednarek and Bero and delegate these actions to the headend facility. Set top boxes are also well known in the art at the time the invention was made to be two way communication devices and it would have been obvious for the primary device to alert the headend when a secondary device is

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outside of the proximity of the primary device indicating possible unauthorized access to services.

13. Regarding claim 14, Bero discloses that a slave unit is sent a desired distance from the master unit and the master unit stores the signal strength. This is essentially is the predetermined distance that is claimed in claim 14. (See paragraph 0024 lines 11-13).

14. Regarding claim 15, Bero discloses using received signal strength measurements to determine the distance of slave units (See paragraphs 0032 lines 1-3). This measurement is used to determine the distance of the slave unit. If the signal is weaker than the predetermined threshold, then the distance of the slave unit is greater than the predetermined distance. If the signal strength is stronger than the slave unit is at a closer distance than the predetermined distance.

15. Regarding claim 16, Bero discloses using Bluetooth with a received signal strength indicator (RSSI) (See paragraph 0013 lines 7-12 and paragraph 0016 lines 1-7). Using UWB communications is an obvious variant of Bero's invention because UWB is also useful in short distance communication. Bero discloses his motivation for using Bluetooth due to it being very compact, cost effective, and most effective in picocell local area networks.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sari Sawaged whose telephone number is (571) 270-5085. The examiner can normally be reached on Mon-Thurs, 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doon Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS DOON CHOW
SUPERVISORY PATENT EXAMINER